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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HAVAN, THU THAO

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/920,546

Applicant(s)

ROERICK, MICHAEL L.

Examiner

Thu Thao Havan

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/6/04; 12/26/01</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Drawings

The Examiner accepts the drawings filed on January 9, 2002.

Specification

The disclosure is objected to because of the following informalities: There are misspelled words in the specification. In paragraph 16, misspelled words such as "bidirectional" and "fo". In paragraph 43, misspelled word such as "an d".

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth below:

whether the invention falls under the statutory category of a process, machine, article of manufacture or composition of matter; and whether it produces a useful, concrete, and tangible result. In the instant application, claims 1-8 recite "a message format" and its characteristic. A message format as claimed pertains to computer-related nonstatutory subject matter. It is merely a listing of data, i.e., non-functional descriptive material. In other words, a "mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture or composition of matter". (See *Interim Guidelines, Annex IV (b)*). Furthermore, claims 1-8 as recited, fail to relate to a practical application that produces a useful, concrete, and tangible result. (See *Interim Guidelines, IV (C)(1, 2)*).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-8** are rejected under 35 U.S.C. 102(e) as being anticipated by Ohki et al. (US 5,952,639).

Re claim 1, Ohki teaches a message format for use in communicating information
(col. 5, lines 21-36; col. 8, lines 16-41; Ohki teaches a message format when he discloses a

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user's request to carry out a particular operation such as deposit a check. A user's request is a type of message format) comprising:

a plurality of message segments, each message segment having one or more data fields (col. 5, lines 27-36; col. 8, lines 16-21; Ohki teaches a plurality of menus for a user to select from a touch screen panel in an ATM);

a first message segment having at least one data field storing data that does not change for each communication of financial information (col. 8, lines 16-21; Ohki discloses a first message segment when he discloses a menu. This menu is static because the data do not change since the data includes consistent menu items for a user to select such as to deposit money.);

a second message segment having an arrangement of data fields that store data as a function of the type of financial transaction, and said arrangement of data fields changes for different financial transactions (col. 8, line 19 to col. 9, line 30; Ohki discloses a second message when he discloses the deposit menu changes due to user selecting either cash or electronic money to be deposited.); and

said first message segment having a field that defines a format of the data fields of said second message segment, whereby the format of said second message segment is variable and changes as a function of the type of financial transaction communicated (col. 8, line 11 to col. 9, line 64; Ohki teaches a first message as static menu having field such as many different menu items. As for the second message, he discloses a dynamic or changing deposit menu that changes in relation to user's selection cash or electronic money).

Re claim 2, Ohki teaches a third message segment having a plurality of fields, an arrangement of the fields of said third segment being a function of the type of goods/service to purchase, and further including at least one field in said first message segment defining a format of the arrangement of data fields in said third segment (col. 19, lines 30-67). Ohki teaches a third message when he discloses the ATM touch panel has electronic money in an IC card wherein the user can purchase commodities and can receive a variety of services relating to electronic money. The field in the first message is related to the third message since the menu is the ATM touch panel is the same.

Re claim 3, Ohki teaches first message segment has a data field that defines a terminal from which a user of the terminal initiates a financial transaction, and said second message defines a method of payment chosen by the user of the terminal (figs. 1 and 3). Ohki discloses in the bank branch system, banking teller terminals are connected to an automatic teller machine by way of an internal communication line. The banking teller terminals and the automatic teller machine are connected to the bank computing center by way of a relay computer. Thus, the banking teller terminals and the automatic teller machine are connected to an electronic value box by way of an electronic-money transaction management terminal. These are two terminals interacting with each other to transfer messages such as financial transaction like depositing money.

Re claim 4, Ohki teaches third message segment includes at least one data field relating to a product or service being purchased by the user via the terminal (col. 19, line 44 to col. 20, line 28). Ohki discloses a POS terminal for user to purchase product or services.

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Re claim 5, Ohki teaches one data field of said second message segment is adapted for holding data indicating that a chosen method of payment by the user is currency (col. 8, lines 19-37). Ohki discloses cash or electronic money. Cash is a currency.

Re claim 6, Ohki teaches second message segment includes different numbers of data fields as a function of the methods of payments allowed by the terminal, and the data in the respective fields is different (col. 8, lines 19-67). Ohki discloses different numbers of data fields when he discloses different options in a deposit menu such as permitting the user to select either cash or electronic money.

Re claim 7, Ohki teaches a message format for use in communicating financial information (col. 5, lines 21-36; col. 8, lines 16-41; Ohki teaches a message format when he discloses a user's request to carry out a particular operation such as deposit a check. A user's request is a type of message format), comprising:

a first message segment (col. 8, lines 16-21), a second message segment (col. 8, line 19 to col. 9, line 30) and a third message segment (col. 19, lines 30-67);

said first message segment having one or more data fields storing data for identifying a terminal from which a financial transaction is communicated using said message format, said first message segment having at least one data field defining an arrangement of data fields of said second message segment, and said first message segment having at least one data field defining an arrangement of data fields of said third message segment (col. 8, lines 16-21; Ohki discloses a first message segment when he discloses a menu. This menu is static because the data do not change since the data includes consistent menu items for a user to select such as to deposit money.);

said second message segment for carrying data in respective fields thereof relating to a method of payment selected by a user using the terminal (col. 8, line 19 to col. 9, line 30; figs. 1 and 3; Ohki discloses a second message when he discloses the deposit menu changes due to user selecting either cash or electronic money to be deposited.); and

said third message segment for carrying data in respective fields thereof relating to an identification of goods or services selected by the user of the terminal (col. 19, line 44 to col. 20, line 28; Ohki discloses a POS terminal for user to purchase product or services.).

Re claim 8, Ohki teaches a data field of said first message segment specifies one of a method of payment selected from a group consisting of ATM card, credit card, debit card, smart card or cash (col. 8, line 12; col. 4, lines 40-65; figs. 6 and 2). Claim 8 is a markush claim, thus Examiner takes the position of addressing one element (ATM). Ohki clearly teaches an ATM. On a further note, the phrase "or" as claimed only requires one element be met by the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bowen et al, US 6,094,649

Bilger et al, US 6,317,835

Gilles, US 6,137,873

Gustin et al., US 5,897,625

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Thu Thao Havan
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8/7/2006